

IN THE UNITED STATES DISTRICT COURT FOR THE
EASTERN DISTRICT OF MISSOURI

VICTORY OUTREACH
INTERNATIONAL CORPORATION
a California nonprofit corporation

Plaintiff,

v.

TWITTER, INC.
a Delaware corporation

and

VICTORY OUTREACH
MINISTRIES CHURCH
a Missouri nonprofit corporation

Defendants,

CIVIL ACTION NO. 4:13-cv-01501-HEA

CONSENT JUDGMENT

The parties have reached agreement on terms of settlement and mutually consent to the following findings of fact, conclusions of law, and relief. This Court has considered these findings, conclusions, and relief granted and concludes that they are appropriate and should be entered as a final judgment in this action.

Based upon all the records herein, the Court makes the following findings of fact and conclusions of law:

PARTIES AND JURISDICTION

1. Plaintiff Victory Outreach International Ministries (“plaintiff”) is a California nonprofit corporation, with its principal place of business in San Dimas, California. Victory Outreach operates under the name Victory Outreach International.

2. Defendant Twitter, Inc. (“Twitter”) is a Delaware corporation having its principal place of business in San Francisco, California. Defendant does business in this District and, therefore, is subject to the jurisdiction of this Court.

3. Defendant Victory Outreach Ministries Church (“VOMC”) is a Missouri nonprofit corporation having its principal place of business in St. Louis, Missouri. Defendant does business in this District and, therefore, is subject to the jurisdiction of this Court.

4. This Court has jurisdiction over the subject matter of this action under 15 U.S.C. § 1121, 28 U.S.C. §§ 1331 and 1338 (a) and (b), and has supplemental jurisdiction under 28 U.S.C. § 1367(a) over plaintiff’s claims under state law. In addition, this Court has subject matter jurisdiction over the claims herein pursuant to 28 U.S.C. § 1332 because this is a civil action between two citizens of different states and the amount in controversy is in excess of \$75,000, exclusive of interests and costs.

FINDINGS OF FACT AND CONCLUSIONS OF LAW

5. Plaintiff was founded in 1967 and has grown to become a network of over 600 churches and ministries, with locations across the United States and in thirty countries from the Philippines to the Netherlands. As such, plaintiff has grown into one of the largest inner-city ministries of the world, meeting the needs of people from a variety of backgrounds.

6. Plaintiff has branded its churches and ministries with the “Victory Outreach” trademark, which was registered on September 21, 1981, under Registration Nos. 1,210,107 and 1,210,108 (the “Victory Outreach Trademarks”). The Victory Outreach Trademarks are currently in full force and have become incontestable under 15 U.S.C. § 1065.

7. Over time, Victory Outreach International has registered other trademarks in protection of its rights. VICTORY OUTREACH G.A.N.G. INTERNATIONAL was registered on February

19, 2008, under Registration No. 3,384,310; VICTORY OUTREACH INTERNATIONAL UNITED WE CAN was registered on May 22, 2012, under registration No. 4,185,058; and VO VICTORY OUTREACH INTERNATIONAL SINCE 1967 was registered on June 12, 2012, as Registration No. 4,197,038.

8. VOMC was organized as a nonprofit corporation in the state of Missouri in 2009.

9. On October 9, 2010, VOMC filed an intent-to-use for the trademark VICTORY OUTREACH MINISTRIES CHURCH with the United States Patent and Trademark Office (“USPTO”), Serial No. 85/149,006. VOMC’s application for registration of this trademark was not granted by the USPTO and, thereafter, was abandoned by VOMC. Through the course of this filing with the USPTO, VOMC was made aware of plaintiff’s ownership of the VICTORY OUTREACH trademarks.

10. Nonetheless, VOMC has continued to use the VICTORY OUTREACH trademarks in the promotion of its church and ministries in violation and infringement of plaintiff’s intellectual property rights under federal and state law.

11. On or about February 11, 2013, representatives of plaintiff sent to representatives of VOMC an email demanding that defendant cease and desist from further use of the VICTORY OUTREACH trademarks.

12. On or about March 25, 2013, through counsel, plaintiff again sent VOMC written correspondence demanding that VOMC cease and desists from further use of the VICTORY OUTREACH trademarks.

13. Notwithstanding VOMC’s knowledge of plaintiff’s ownership of VICTORY OUTREACH trademarks through the United States Patent & Trademark office and the two cease

and desist letters sent by plaintiff to VOMC, VOMC has continued to infringe the VICTORY OUTREACH trademarks in violation of plaintiff's rights.

14. VOMC's infringement as described herein has caused plaintiff to suffer damages in excess of \$75,000.

15. VOMC also registered the username "VICTORYOUTREACH" with defendant Twitter.

16. VOMC's use of the name VICTORY OUTREACH infringed on plaintiff's registered trademarks in violation of federal and state law.

17. Use of the term VICTORY OUTREACH in connection with on-line social media accounts is likely to cause confusion, deception or affiliation between Plaintiff and defendant VOMC.

ORDER

Having made the preceding finds of fact and conclusions of law, this Court orders as follows:

a. VOMC and its agents, servants, employees, and attorneys, and all other persons in active concert or participation with them, are permanently enjoined and restrained from using the name and mark "Victory Outreach," and any other mark, trade name, corporate name, or domain name that is confusingly similar to Plaintiff's mark or likely to dilute their distinctive quality (including, but not limited to, a combination of synonyms of VICTORY and OUTREACH).

b. Within thirty (30) days after the entry of this Consent Judgment, VOMC to transfer to plaintiff the domain name <http://www.victoryoutreachministrieschurch.com>;

c. Within thirty business days after the entry of this Consent Judgment, VOMC shall file with the Missouri Secretary of State documents to effectuate an amendment of the corporate

name for VOMC to a name in compliance with paragraph (a) above and shall contemporaneously provide plaintiff's counsel with a copy of such documents.

d. Within thirty (30) days after the date of this Consent Judgment, VOMC shall identify all known directories (online and print) which list VOMC using the terms VICTORY OUTREACH and request the removal from these directories any listing identifying VOMC and the terms VICTORY OUTREACH or any derivative or combination of such words. VOMC shall follow up with these directories for a one (1) year period or any other identified directories requesting removal of any non-removed listings.

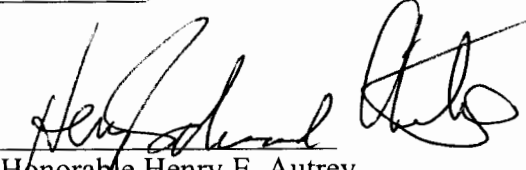
e. Within thirty (30) days after the entry of this Consent Judgment, VOMC shall transfer to plaintiff any other domain name owned or controlled by VOMC containing to words VICTORY OUTREACH, or any derivative or combination of those words. Plaintiff shall provide any necessary assistance to facilitate said transfer.

f. Pursuant to Rule 65(d), Fed. R. Civ. P., this Consent Judgment is binding upon both of the Defendants, Plaintiff, their officers, agents, servants, employees, and attorneys, and upon those persons in active concert or participation with them who receive actual notice thereof by personal service or otherwise.

g. The parties shall each bear their own costs in this action.

h. This judgment shall have res judicata and collateral estoppel effect as to all findings and conclusions contained herein and all claims and defenses asserted in the lawsuit.

SO ORDERED this 31st day of June, 2013.


Honorable Henry E. Autrey

United States District Court

The parties hereby agree to the terms of this Consent Judgment:

Approved as to form:

FOR PLAINTIFF:

/s/ Bryant S. Ash

By: Bryant S. Ash, MO # 63,693

Arthur K. Shaffer, MO # 51,229

7101 College Blvd.

Suite 1520

Overland Park, KS 66210

Telephone: (913) 345-0900

Facsimile: (913) 345-0903

ashaffer@theipcenter.com

ATTORNEYS FOR VICTORY OUTREACH
INTERNATIONAL CORPORATION

FOR DEFENDANTS:

/s/ Annette P. Heller

By: Annette P. Heller MO #26748

400 Chesterfield Center, Ste 400

Chesterfield MO 63017

Telephone: 414-469-2610

Facsimile: 314-469-4850

tmattorneyheller@aol.com

ATTORNEY FOR VICTORY OUTREACH
MINISTRIES CHURCH